

## **REMARKS**

This Amendment is submitted in response to the March 16, 2006 Final Office Action. By this Amendment, claims 1 and 2 have been amended as indicated above. No new matter has been added. Upon entry of this Amendment, the pending claims will be amended independent claims 1 and 2, with claims 3-12 depending from claim 1.

The present invention is directed to a thimble for use in quilting. The inventor has discovered that by keeping the user's finger that is wearing the thimble substantially straight at the first knuckle position, the user can apply an increased force, i.e. better leverage, to the needle for pushing the needle through the quilt while maintaining contact between the needle tip and the thimble via indents or rigids provided in the thimble surface. The indents secure the needle tip, namely, the blunt end of the needle, to the thimble so that the needle tip does not slip along the thimble surface. In accordance with the present invention, the thimble is dimensioned to extend over the first knuckle of the user's finger so that the first two bones of the finger on either side of the first knuckle are relatively collinear. The thimble is also designed so that its entire leading edge circumference, i.e., the edge remote from the finger tip, extends below the first knuckle in order to encircle the circumference of the finger.

In accordance with the amended claims, a thimble is recited which is adapted to extend over the first knuckle position of a single one of a user's fingers, about the finger's full circumference. The thimble is comprised of "a rigid material to prevent bending of the user's finger at the first knuckle position". The thimble also comprises one or more indents on a needle contacting surface which are "configured to secure a tip of a needle disposed in one of the indents". Support for the amendments are found in ¶0007 and ¶0014.

Turning now to the Office Action, the rejection of claims 1, 3, 5 and 6 as allegedly anticipated by U.S. Patent No. 5,609,165 to Lambert has been maintained because:

“The sole issue regarding Lambert is whether or not the thimble of Lambert is substantially rigid. The Examiner believes the prior art to Lambert is a substantially rigid thimble because it is fabricated from stainless steel. Applicant’s instant invention is also fabricated from stainless steel (see specification page 7, lines 5-6). There is no mention in applicant’s specification regarding the thickness of the material, etc. Additionally, the terminology used by the applicant “substantially rigid” does not mean that the finger is completely straight. The specification allows for the finger to be bent not more than 25° (refer to claims 10 and 11).”

Office Action, P. 2 line 16 – P. 3 line 4

Initially, it is noted that the claims have now been amended to remove the term “substantially rigid”. Instead, the claim has been amended to state “said thimble comprising a rigid material to prevent bending of the user’s finger”. Such an amendment is not inconsistent with the subject matter of claims 10 and 11. Those claims simply recite that the thimble can be configured with different angles so that, when worn by the user, the finger will be maintained at a particular angle, i.e. of not more than 25°. In other words, once such a thimble is worn, it will act “as a brace” such that the first knuckle position will not bend any more than the fixed angle provided by the rigid thimble. Thus, and depending on the user’s preference, a first thimble with no bend will be used, while another user may prefer a thimble with a 25° bend. This interpretation is consistent with the specification. For example, ¶0007 states that the thimble is used “as a brace in order to ensure that the first knuckle position of the thimble bearing the finger used to push the needle is not bent...”. Lambert, however, is directed to a finger protector which allows bending of the wearing finger and is, therefore, flexible. In fact, the title of the Lambert reference is “Flexible Thimble Type Finger Protector”. As explained in the Abstract, when the protector is “worn on a finger, the finger may be bent to a limited extent”. *See also*, Lambert col. 1, lines 46-48. This teaching is contrary to applicant’s invention which, as now stated in amended independent claims 1 and 2, provides for the

thimble to be comprised of “a rigid material to prevent bending of a user’s finger”. For this reason alone, it is believed that the amended claims are patentable over Lambert.

Another reason why the amended claims are patentable over Lambert is because Lambert does not include a needle contacting surface having one or more indents which are “configured to secure a tip of a needle disposed in one of the indents”. Rather, the channel sections (1) shown in figures 1 and 2 of Lambert, will allow a tip of a needle disposed therein to slide outward in a direction perpendicular to the axis of the finger protector. For this additional reason, therefore, the pending claims are not anticipated, nor rendered obvious by, Lambert.

In the Office Action, claims 1-8 and 10-12 also stand rejected as allegedly anticipated by U.S. Patent No. 3,228,033 (Ames et al.). Ames et al. is directed to a finger guard which is “adapted to be placed over the fingers of a person for use while pinning garments, particularly diapers, on a baby.” See, col. 1, lines 8-11. Clearly, therefore, this reference has nothing to do with the subject matter of applicant’s invention, namely, a thimble. The Ames et al. device is wearable on multiple fingers of a user, as shown in figure 1, wherein the device is disposed over an index finger and middle finger of a user’s right hand. Moreover, the “indents” on the surface of the finger guard are not “configured to secure a tip of a needle disposed in one of the indents”. On the contrary, the upper surface of the guard is shaped such that when a point of a diaper pin strikes the surface, further movement “of the pin will cause the point to engage the inclined surface 29 where it will be directed upward for return penetration of the garment to a position for sealing with the usual head of the safety pin.” See, col. 2, lines 24-29. Thus, even assuming for argument sake that the surface regions adjacent the structure 32 as shown on page 5 of the Office Action could be considered to be “surface indents” those regions are not configured to secure a tip of a needle but, rather, are configured to allow for movement of the needle tip so that the safety pin can be closed in an

intended manner. Lastly, there is no teaching or suggestion in Ames et al. that the finger guard is made of “a rigid material to prevent bending of the user’s finger”. Although the reference discloses that the device can be made from “well known synthetic plastics”, this does not teach or suggest that the plastics will “prevent bending of the user’s finger”. For at least these reasons, it is believed that the amended claims are patentable over Ames et al.

On page 6 of the Office Action, the Examiner has also rejected claims 1, 2, 4 and 10-12 as allegedly rendered obvious from the combination of U.S. Patent No. 6,237,148 (Graham) in view of U.S. Patent No. 3,728,736 (Pugh). For the following reasons, this combination does not render applicant’s claims obvious.

Turning first to Pugh, this reference is not related in any way to applicant’s thimble. It is submitted, therefore, that Pugh is directed to non-analogous art and, specifically, to the food preparation art. Moreover, the device of Pugh is not comprised of “a rigid material to prevent bending of the user’s finger at the first knuckle position”. Rather, “an accommodation is provided for the rear of the knuckle so as to give adequate flexibility of the guard when being used”. *See* col. 1, lines 19-23. The extension region (21) shown in figure 2 is “bendable also so that the thumb can be readily worked without interference of material extending over the first knuckle”. *See* col. 2, lines 30-32. In addition, the device includes contact engaging areas 25, 26, 27 and 28. These engaging areas are not “indents being configured to secure a tip of a needle disposed in one of the indents”. Rather, it is submitted, that a tip of a needle disposed therein would be able to move to adjacent indents and, therefore, would provide slippage of the needle end.

As for Graham, this reference is also not directed to the thimble art but is, instead, directed to the food preparation art and, in particular, to a thumb shield for “protecting a user’s thumbs from nicks and cuts when the user is preparing food with sharp kitchen utensils”. *See* col. 1, lines 7-8.

The thumb shielding device does not include any “needle contacting surface indents being configured to secure an end of a needle disposed in one of the indents”, as is now recited in the amended claims. The circumferential grooves 22 shown in figure 4 are contained on a lining 21 on the inside of the thumb shield.

Both Pugh and Graham are related to the food preparation art which is entirely different than the thimble art. Thus, there would be no motivation of one skilled in the thimble art to look to either or both of Pugh and Graham in the manner recited in the Office Action, to obtain the applicant’s thimble. Such a combination could only be obtained through impermissible hindsight. However, even if it is assumed, for argument sake, that such a combination would be proper, the combination still would not teach the thimble as now set forth in applicant’s amended independent claims. Accordingly, it is believed that the claims are patentable over the combination of Pugh and Graham.

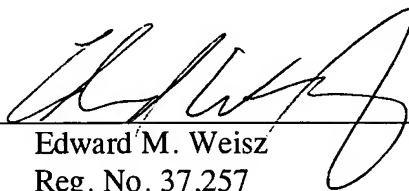
Applicant has reviewed the remaining references cited in the Office Action but which have not been relied upon in rejecting the claims and believes that those references, whether considered alone or in combination with any of the references discussed above, do not render applicant’s amended claims unpatentable.

For at least the foregoing reasons, it is believed that amended independent claims 1 and 2 are now in condition for immediate allowance. Moreover, because claims 3-12 depend from amended independent claim 1, it is believed that those dependent claims are also allowable for at least the same reasons as set forth above.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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Dated: May 15, 2006